

Remarks

By the amendment herein, claims 1, 2, 5, and 6 are amended, claims 3 and 4 are canceled, and claims 7-19 are added.

Support for the amendments to the claims appears throughout Applicants' application as originally filed, for example, pages 3-4, paragraphs [0006]-[0009], page 5, paragraph [0012], pages 6-8, paragraphs [0016]-[0019]. Applicants respectfully submit that the amendments should not be considered to add new matter.

Interview Summary

Applicants express appreciation for the courtesies extended by Examiner Umamaheswari Ramachandran during a February 16, 2010 telephone interview with Applicants' representative Arnold Turk regarding the above-identified application.

During the telephone interview, Applicants' representative indicated that method claims would be added in response to the Office Action, and inquired whether the Examiner would enter and examine method claims if filed in response to the requirement for election of species, with or without the presently pending claims. The Examiner indicated that an action on the merits has not been conducted and that it is permissible for Applicants to submit method claims for search and examination on the merits in response to the Office Action.

Restriction Requirement

The Restriction Requirement requires election of species, by asserting that the application contains claims directed to more than one species of the generic invention, as follows:

Various species of non-natural retinoid having a basic skeleton comprising an aromatic ring bound with an aromatic carboxylic acid or tropolone bound by means of a bridging group.

The Restriction Requirement states that the claims are deemed to correspond to the species in the following manner:

Claims 1-6 correspond to non-natural retinoid species. Claims 5-6 are limited to retinoids, 4-[(5,6,7,8-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl]benzoic acid, or 4-[(3,5-bis-trimethylsilylphenyl)carboxamido]benzoic acid.

The requirement further indicates that claims 1-4 are generic.

Election

In order to be responsive to the requirement for election of species, Applicants elect the species 4-[(5,6,7,8-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl]benzoic acid. Applicants submit that at least claims 1, 2, 5-9, 13-19 are generic, and that at least claims 1, 2, 5-9 and 13-19 are readable on the elected species. Accordingly, claims 10-12 are identified as (New – Withdrawn)

If upon review of the presently pending claims, the Examiner deems that any further election is required, Applicants elect method claims 2 and 5-19. Of course, if the Examiner has any questions or deems that any further election is appropriate, the Examiner is requested to contact the undersigned by telephone.

Traverse

Notwithstanding the election of the species 4-[(5,6,7,8-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl]benzoic acid in order to be responsive to the election of species requirement, Applicants respectfully traverse the requirement.

The Examiner is also reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. 1.475 must be considered. Specifically, Applicants note that 37 C.F.R. 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).

(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking under 1.475. In the instant situation, the requirement does not refer to 1.475, and does not indicate that the requirement is proper in view of this rule.

Furthermore, the requirement fails to indicate whether the technical features of the claimed invention, when considered as a whole, makes a contribution over the prior art. The requirement alleges a lack of a special technical feature relating to the listed species of retinoid 4-[(5,6,7,8-tetrahydro-5,5,8,8-tetramethyl-2-naphthalenyl)carbamoyl] benzoic acid not being novel and references Hashimoto, Cell Structure and Function, 16: 113-123 (1991). However, the requirement merely points to isolated portions of the disclosure of this document, and does not set forth any indication that Applicants' claimed subject matter is sufficiently envisaged in the document so as to constitute anticipation. In this regard, Applicants note that a rejection has not been made based upon the asserted teachings within this document, and preserve their right to present arguments in the event that a rejection is made relative to the subject matter recited in Applicants' claims. In any event, the requirement must establish why unity of invention is lacking based upon reference to 37 C.F.R. 1.475, as discussed above.

In view of the foregoing, it is respectfully requested that the Examiner reconsider the requirement for election of species, and withdraw the same so as to give an examination on the merits on all of the claimed subject matter and species pending in this application.

In any event upon allowance of generic claims, the Examiner is respectfully requested to rejoin the non-elected species.

CONCLUSION

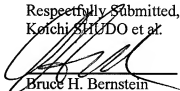
For the reasons discussed above, it is respectfully submitted that the requirement for election of species is improper and should be withdrawn.

Withdrawal of the requirement for species election with the examination of all claims pending in this application is respectfully requested.

Favorable consideration with early allowance of the pending claims is most earnestly requested.

If the Examiner has any questions, or wishes to discuss this matter, please call the undersigned at the telephone number indicated below.

Respectfully Submitted,
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